REMARKS

Claims 72, 77, 80-87, 89-91, 94, and 98-99 are pending in the application. Claim 73 has been cancelled from the application without prejudice in this Reply. Claims 76, 86 and 94 are withdrawn from consideration. Claim 72 has been amended in this Reply to clarify what it is that the Applicant's regard as their invention. No new matter has been added to the application by way of these changes.

The Examiner's claim objections and rejections are overcome or are traversed as set forth below.

I. THE 112, 1st PARAGRAPH REJECTION

The Examiner rejected claims 73-73, 77, 80-85, 87, 89-91 and 98-99 under 35 USC § 112, 1st paragraph for containing subject matter that is not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.

This rejection has been overcome by amending claim 72 to recite a single method for applying a reagent to the biological sample. Claim 73, which is directed to the cancelled method for applying a reagent to a biological sample, has been cancelled from the application. The Applicant's reserve the right to file claims in a continuing application that are directed to the cancelled method for applying a reagent to a biological sample.

II. THE ANTICIPATION REJECTION

The Examiner rejected claims 72, 77, 80-81, 84-85, 87, 89, 91, and 98 for being anticipated by Mazza et al. (USP 4,815,978).

In order for a reference to anticipate, all elements of the claimed invention must be found identically in a single prior art reference. *See General Electric Co. v. Nintendo Co., Ltd.*, 50 USPQ2d 1910, 1915 (Fed. Cir. 1999). The Mazza et al '978 patent reference does not meet this standard. Claims 72, 77, 80-81, 84-85, 87, 89, 91 and 98 are not anticipated at least because the '978 patent does not disclose applying an evaporation-inhibiting liquid phase to a sample undergoing testing.

The Examiner points to col. 8, lines 38-48 of the '978 patent for teaching the addition of an evaporation inhibiting layer to a test sample. This excerpt, reproduced below, does not disclose or

suggest the addition of an evaporation-inhibiting layer to a test sample.

> By directing the air jet J at an acute angle at the junction of the liquid surface in the cuvette with the partially closed top (opening) portion with the cuvette wall, preferably so that the air jet hits the meniscus at this junction, a vortex is created which produces a thorough mixing of the contents of the cuvette. This mixing is such that even a reagent which is particularly immissible in the diluent becomes totally suspended within the diluent and the reaction between the reagent and the sample is more complete and rapidly achieved.

('978 patent, col. 8, lines 38-48). This excerpt of the '978 patent merely indicates that one reagent in the cuvette may be immiscible in a diluent. Moreover, this excerpt teaches that the air mixing should be so vigorous that the immiscible reagent becomes "totally suspended within the diluent". As a result this excerpt and the remainder of the '978 patent fail to teach several elements of the claimed invention including that (1) the immiscible fluid covers the reagent; and (2) that the immiscible fluid remains in place to preserve the biological sample from dehydration from the air stream. The immiscible fluid of the '978 patent that becomes "totally suspended" in the reagent cannot accomplish either of these claimed features of the present invention.

The '978 patent reference is silent about adding an evaporation inhibiting liquid to the cuvette. Therefore, the '978 patent cannot anticipate because it does not disclose each element of the invention of each of claims 72, 77, 80-81, 84-85, 87, 89 and 91.

III. THE OBVIOUSNESS REJECTION

The Examiner rejected claims 90 and 99 for being anticipated by Mazza et al. (USP 4,815,978).

Claims 90 and 99 are not anticipated because the Examiner has not established a *prima facie* case of obviousness for at least the same reasons set forth in Section II above. Specifically, claims 90 and 99 are not obvious over the teachings of the '978 patent because the '978 patent does not disclose or suggest the use of an evaporation inhibiting liquid.

A second and independent grounds for the patentability of claims 90 and 99 is because it would not have been obvious to apply the '978 teachings involving air mixing of the liquid contents of a cuvette to tests performed on slides. Performing tests on slides present different and unique problems in comparison to tests performed in cuvettes. A primary difference is that cuvettes are vessels in which test materials are held. The cuvette shape prevents the liquid test materials from

escaping during air agitation. Liquid test materials placed on slides are not held in place. Applying air to liquid materials on a slide could cause the materials to be ejected completely from the slide. Therefore, it would not be obvious from the '978 patent that air agitation could be applied to liquid test materials on a slide. Claims 90 and 99 are, therefore, believed to be non-obvious over the '978 patent for this reason as well.

CONCLUSION

In view of the claim amendments and in view of the statements in favor of patentability presented above it is believed that all pending claims 72, 77, 80-87, 89-91, 94, and 98-99 of this application are allowable. Favorable reconsideration and allowance of the pending application claims is therefore courteously solicited.

Respectfully submitted,

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By: _____

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